

Remarks

Applicants respectfully traverse the restriction requirement for the following reasons:

**I. The restriction requirement is improperly based on the drawings, not the claims.**

The pending restriction requirement is based on the various figures of the application rather than the pending claims. The articulated "groupings" for restrictions are two different combinations of figures in the Drawing—No groupings of claims have been identified by the Examiner for restriction within the overall grouping of claims 1-10 and 18-44; the Applicants have been left to determine this for themselves.

Since it is the claims that define the metes and bounds of the invention, not the drawings, a restriction requirement based solely on the drawings is not and cannot be proper. See 35 U.S.C. 121:

If two or more independent and distinct inventions are claimed in one application, the director may require the application to be restricted to one of the inventions...

See also the Manual for Patent Examining Procedure (MPEP) 803:

**803 Restriction - When Proper**

Under the statute an application may properly be required to be restricted to one of two or more *claimed inventions* only if they are able to support separate patents and they are either independent...or distinct. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

8<sup>th</sup> Ed., Aug. 2001 (emphasis supplied). The consistent criterion for restrictions, in the statute, the

BUR919990305US1

2

S/N 09/944,665

regulations, and the MPEP, is the claimed invention, not the depicted invention. In the pending restriction requirement the requirement is based solely on the figures. Applicants respectfully submit that the rationale for the pending restriction requirement is improper, because nowhere in the statute, regulations, or MPEP is there any indication that a restriction requirement based solely on the Drawing is proper. As such, Applicants respectfully submit that the pending restriction requirement should be reconsidered and withdrawn.

**II. The Examiner has not articulated a sufficient reason to insist on the restriction.**

As stated in MPEP 808:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

Id. (emphasis in original). As previously stated, Applicants respectfully submit that the present restriction should be withdrawn because it does not meet requirement (A) - that is, it fails to articulate why the inventions *as claimed* are independent or distinct. Applicants also respectfully submit that the restriction requirement is improper because it fails to articulate a sufficient reason to insist on the restriction, per the requirement (B) of MPEP 808. That is, even if a proper rationale was articulated for the restriction, Applicants respectfully submit that there is no rationale for insisting on the restriction.

MPEP 808 addresses "the reasons for insisting upon restriction" separately for inventions that are "independent" and inventions that are "distinct." The Examiner has not directly specified which of these rationales are applicable to the invention; the Examiner simply uses the label "patentably distinct species." Because the exact rationale is unclear, both the "independent" and "distinct" rationales will be discussed in more detail below.

BUR919990305US1

**A) Insisting on Restriction for "Independent Inventions." See MPEP 808.01:**

**808.01 Independent Invention**

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP 806.04), the facts relied on for this conclusion are in essence the reasons for insisting upon restriction...

8<sup>th</sup> Ed., Aug. 2001 (emphasis in original). Applicants respectfully submit that these requirements are not met in the subject application. Ignoring for the moment the clear reference to the "inventions claimed," Applicants respectfully submit that the "embodiments" suggested by the Examiner are clearly "connected in design, operation, or effect" as set forth in the MPEP. In the present invention, both "embodiments" are for a vertical FET. The depicted vertical FETs are in fact "connected in design" (both have a vertical channel, with vertically-displaced source and drain regions); "connected...in operation" (both vertical FETs would operate the same general way in controlling the conductivity of an FET channel region); and "connected...in effect" (the result is the creation of a vertical channel region, enhancing silicon productivity). Thus, Applicants respectfully submit that ALL of the potential "connections" between the restricted "embodiments" are present; note that ONLY ONE is required by this section of the MPEP. Thus, to the extent the "embodiments" are deemed "independent," there is no rationale for insisting on restriction therebetween.

**B) Insisting on Restriction for "Distinct Inventions." See MPEP 808.02:**

...where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

BUR919990305US1

- (a) Separate classification thereof....
- (b) A separate status in the art when they are classifiable together...
- (c) A different field of search....

Id. Applicants respectfully submit that none of these criteria have been articulated by the Examiner to justify the restriction requirement. Applicants respectfully submit that none are applicable - the "embodiments" are both related to vertical FETs, so it would appear most likely that they would be classified in the same areas and would have common search strategies.

In view of the foregoing, Applicants respectfully submit that no rationale exists for "insisting on the restriction" per the requirements of MPEP 808, whether the separate "inventions" are considered "independent" or "distinct." As such, Applicants respectfully submit that the pending restriction requirement should be reconsidered and withdrawn.

In summary, Applicants respectfully request that the pending restriction requirement be reconsidered and withdrawn, because (a) the rationale for the restriction, based on the figures rather than the claims, is improper, and (b) even if the rationale for the restriction was proper, there is no reason for "insisting on the restriction" as required by the MPEP.

BUR919990305US1

5

S/N 09/944,665

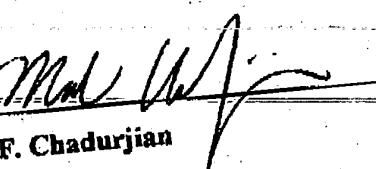
AUG 12 2002 12:53 FR BTU IPLAW

8027698938 TO 917038729318

P.06/06

Applicants respectfully request entry of the present response, and passage of their subject application to issuance in view thereof. Should the Examiner have any comments, questions, or suggestions, please do not hesitate to contact the undersigned attorney at the telephone number and/or email address set forth below.

Respectfully submitted,  
For: Furukawa et al.

By:   
Mark F. Chadurjian

Reg. No. 30,739  
Telephone: (802) 769-8843  
Facsimile (802) 769-8938  
Email: mchadurj@us.ibm.com

IBM Corporation, IPLaw Dept. 972E  
1000 River Street  
Essex Junction, VT 05452

S/N 09/944,665

6

BUR919990305US1

Received from <8027698938> at 8/13/02 12:50:57 PM (Eastern Daylight Time)

\*OK TOTAL PAGE.06 \*OK